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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,365	12/21/2000	Jerry B. Decime	10002106-1	2157

7590 09/15/2009
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER	
LEE, PHILIP C	

ART UNIT	PAPER NUMBER
2448	

MAIL DATE	DELIVERY MODE
09/15/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY B. DECIME

Appeal 2008-000402
Application 09/746,365¹
Technology Center 2400

Decided: September 15, 2009

Before ALLEN R. MACDONALD, JAY P. LUCAS, and ST. JOHN
COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals from a final rejection of claims 1-8, 10-14, 16-18
and 20-25 under authority of 35 U.S.C. § 134. Claims 9, 15, and 19 are

¹ Application filed December 21, 2000. The real party in interest is Hewlett
Packard Development Corp, LP.

cancelled. (App. Br. 2). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a system and method for directing e-mails to the correct person in an organization dependent on the language and the topic of the e-mail. In the words of the Appellant:

After a client or potential client accesses the web-site of a host organization and generates an e-mail to the organization, an e-mail sorting and routing system parses the meta-tags appended to the message to appropriately sort and route the message. The meta-tags specify the language of the client, i.e., the language in which the web-site was communicating with the client when the message was generated. The meta-tags also specify the topic, e.g. a product or service, about which the message was written. This information may be input by the client or ascertained from the content or purpose of the web-page from which the e-mail was generated. The messages are then sorted, first by language and then by topic. As a result, each message is quickly routed to a person qualified as to both language and subject matter who can respond to the client.

(Spec. 16, Abstract.)

Claim 1 is exemplary:

1. An e-mail sorting and routing system, the system comprising:

a web server for providing a web-site at which clients generate e-mail messages to a host organization, the web server being configured to determine the language in which the web-site is written and to append a meta-tag to each e-mail message that identifies that web-site language; and

a response server configured to sort the e-mail messages by language through reference to the appended meta-tags.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ayyadurai	US 6,718,367	Apr. 6, 2004
Mowbray	EP1024447 A2	Aug. 2, 2000

Ponfoort, *Support your e-commerce with an e-center*, World Trade, July 2000, at 66-68 (hereinafter “World Trade”).

Novell’s Breaththrough Language Identifier, Newsbytes, no. pNEW08040047, Aug. 4, 1997 (hereinafter “Newsbytes”).

Talisma Enterprise’s Multiple Language Capabilities enable companies to build strong global customer relationships, PR Newswire, Aug. 10, 2000 (hereinafter “Newswire”).

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1-8, 10-14, 16-18, and 20-25 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite.

R2: Claims 1, 5, 6, and 22 stand rejected under 35 U.S.C. § 103(a) for being obvious over Newsbytes or Worldtrade or Newswire in view of Mowbray.

R3: Claims 2-4, 7, 8, 10-14, 16-18, 20, 21, and 23-25 stand rejected under 35 U.S.C. § 103(a) for being obvious over Newsbytes or Worldtrade or Newswire in view of Mowbray and further in view of Ayyadurai.

Groups of Claims:

The arguments will be addressed in the order of their presentation.

See 37 CFR § 41.37 (c) (vii).

Appellant contends that the claimed subject matter is not indefinite, merely broad, and is not rendered obvious by Newsbytes or Worldtrade or

Newswire in view of Mowbray alone or in combination with Ayyadurai because the references fail to disclose claimed limitations. The Examiner contends that each of the claims is properly rejected (Ans. 19, bottom).

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We reverse all rejections.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, paragraph 2, and 35 U.S.C. § 103(a). The issue under 35 U.S.C. § 112, paragraph 2, turns on whether alleged inoperability of the invention is a ground for rejection under 35 U.S.C. § 112, paragraph 2. The issue under 35 U.S.C. § 103 turns on whether the references teach determining the language of an e-mail based on the language of the web-site from which it was generated, as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented a method and system for properly routing e-mails from clients of a website, for example a company's website (Spec. 3, 1. 10). When the e-mail is generated by the website, the system appends meta-tags to the e-mail indicating the language and topic of the website

- (Spec. 3, l. 25). When the e-mail is received by the company's response server, it can be routed to an agent knowledgeable in the language and topic area as indicated by the meta-tags (Spec. 4, l. 8).
2. The non-patent literature references World Trade, Newsbytes and Newswire each teach the automatic labeling of emails and other such documents based upon a language analysis of the text. Based upon this classification, each reference routes or directs the e-mail to an agent skilled in that language (World trade, p. 1, bottom; Newsbytes, p. 1, middle; Newswire, p. 1, middle).
 3. The EPO Patent Application Mowbray sorts incoming e-mail messages by topic identifiers in the address line of an incoming e-mail (col. 9, top).
 4. U.S. Patent Ayyadurai automatically analyzes the header and body sections of e-mails to determine information about the writer (col. 4, ll. 30-40; 55-65). By analyzing the e-mail using morphology, natural language processing syllabic analysis and other techniques, the system can determine, among other things, how annoyed the writer was (col. 5, l. 28; col. 4, ll. 8-12).

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of

nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

For post-prosecution analysis, our guiding courts use the following analysis: A patent claim is not invalid for indefiniteness unless it is insolubly ambiguous; therefore, if the meaning of the claim is discernible, the claim is sufficiently clear to avoid invalidity on indefiniteness grounds, even if interpreting the claim is difficult, and construction is one over which reasonable persons could disagree. *Bancorp Services LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367 (Fed. Cir. 2004).

However, during prosecution before this Office, while Appellant still has the opportunity to amend the claims, a higher standard of clarity is required:

In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim

unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.
Ex parte Kenichi Miyazaki, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential opinion).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellant's claims under 35 U.S.C. § 112, paragraph 2, and 35 U.S.C. § 103(a) on pages 3-13 of the Examiner's Answer. In opposition, Appellant presents a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 8, 10 to 14, 16 to 18, and 20 to 25
under 35 U.S.C. § 112(para. 2) [R1]*

The Examiner explains this rejection as follows:

A web site is usually written with a specific language, and e-mails written from the web site are written using the same language. It is obvious that if a customer writes an e-mail with a language different from the web-site language, it will be appended with a meta-tag that refers to the web-site language "a wrong one."
(Ans. 5, middle).

In essence, the Examiner is stating that the invention infers that the language of the user's e-mail will be that of the web page, and because a user may choose to use a different language than that of the web-site, the claims are indefinite. Appellant was correct in challenging this interpretation of indefiniteness under 35 U.S.C. 112, paragraph 2.

This Board has recently clarified the standard for indefiniteness for claims before the Office.

In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more

plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

Ex parte Kenichi Miyazaki, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential opinion). The Examiner’s explanation seems to address the issue of operability, rather than indefiniteness.

We do not find that the recited claims are amenable to two or more plausible claim constructions. We also decline to impose a rejection under 35 U.S.C. § 101 for inoperability. The claims as recited are clear, and the fact that the accuracy of the sorting by the response server may be occasionally “wrong” is a risk that the inventor has assumed. That may be a marketing or reliability consideration, but it is not an issue of indefiniteness under § 112, second paragraph.

We conclude that the rejection [R1] under 35 U.S.C. § 112, second paragraph, is in error.

*Arguments with respect to the rejection
of claims 1 to 8, 10 to 14, 16 to 18, and 20 to 25
under 35 U.S.C. § 103(a) [R2 and R3]*

We will address both rejections [R2] and [R3] under 35 U.S.C. § 103 together.

Appellant argues that after review of Newsbytes, WorldTrade and Newswire references he “found no teaching of a ‘web server’ at which e-mails can be generated and a separate ‘response server’ that sorts the e-mail messages by language”. (App. Br. 10, bottom, to 11, top). The Examiner points to paragraphs of the respective references (Ans. 6, middle), but

though we see mention of e-mails, we do not see mention of web-site generated e-mails. As e-mails may be generated by other means than web-sites, we cannot call them inherent. See *Continental Can*, 948 F.2d at 1268.

Appellant also argues that the references fail to teach determining “the language in which the web-site is written”. We agree; this is also missing from the references.

Either or both of these failures of teachings in the references are dispositive of the rejection, and we need not address Appellant’s other contentions. The rejection was made in error.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1-8, 10-14, 16-18, and 20-25 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a).

DECISION

The Examiner’s rejection [R1] of claims 1-8, 10-14, 16-18, and 20-25 under 35 U.S.C. § 112, second paragraph, is reversed. The Examiner’s rejection [R2] and [R3] of claims 1-8, 10-14, 16-18, and 20-25 under 35 U.S.C. § 103(a) is reversed.

REVERSED

peb

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